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| 10/595,617 | 05/01/2006 | Paul Kenneth Rand | PB60534USW | 3613 |

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| EXAMINER |
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WON, BRIAN D

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| ART UNIT | PAPER NUMBER |
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07/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/595,617 | Applicant(s) RAND, PAUL KENNETH | |
| | Examiner BRIAN WON | Art Unit 3771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/01/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/01/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/01/06 & 05/11/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is response to the preliminary amendment filed on 05/01/06. Applicant has amended claims 1-5, 7-9, 11-14, 17-19, 21, 23-27 and 29-32 and cancelled claim 33. Currently, claims 1-32 are pending in this instant application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13, 27-28 and 30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, it is unclear what disclosed structure is the "drive wheel train"

Regarding claims 27-28, term "endless" is indefinite and is unclear what structural elements are being claimed.

Regarding claim 30, it is unclear what the difference between a bend and a fold is and how the bend can be inside of the fold section.

Claim 30 recites the limitation "the sprocket". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-6, and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanguay (3367535).

Regarding claim 1, Tanguay discloses in figures 1-2, a hand-held device (10) comprising a housing (11, 12), inner area of the housing defining a track, a chain of pills (p) (capsule) in the track and a conveying mechanism (13, 15) to convey the chain along the track.

Regarding claim 2-3, Tanguay discloses a manually operable knob (13) being rotatably mounted to the housing, rotating the conveying mechanism

Regarding claim 5-6, Tanguay disclose a conveying mechanism consisting of a manually operable knob (13) and a sprocket (15) operatively coupled to the knob.

Regarding claim 23-25, Tanguay discloses that the pills are small solid bodies of powder for medicinal purposes (see column 2, lines 11-14).

Regarding claim 26, Tanguay discloses in figure 1-2, the pills being linked together on the strap (CW).

5. Claims 1-2, 4, 7-20, 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Edgerley (WO 03/035151).

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Regarding claim 1, Edgerley discloses a housing (504), a track (500) in the housing, a chain (500) of capsules (see protruding pockets (104, 106, 108) containing medicament in figure 1) in the track (and a conveying mechanism (510, 511, 512, 514, 515, 516, 518, 530) to convey the chain along the track (see pg. 34, lines 20-30).

Regarding claim 2, Edgerley discloses conveying mechanism having a manually operable lever arm (518) for actuating the conveying mechanism.

Regarding claim 4, Edgerley discloses the conveying mechanism, having a sprocket (506) rotatably mounted in the housing and positioned to engage the capsule chain for advancement in the track.

Regarding claim 7, Edgerley discloses the track having a bend and the sprocket located at the bend (see figure below).

Regarding claim 8, Edgerley discloses plurality of sprockets (506, 512) rotatably mounted in the housing and engaging the capsule chain for advancement in the track (500).

Regarding claim 9, Edgerley discloses the track having plurality of bends (two bends are formed between sprockets) and each sprocket (506, 512) located at different bend (see figure below).

Regarding claims 10-11, Edgerley disclose each sprocket (506, 512) located on the inside of the associated track bend. (see figure below)

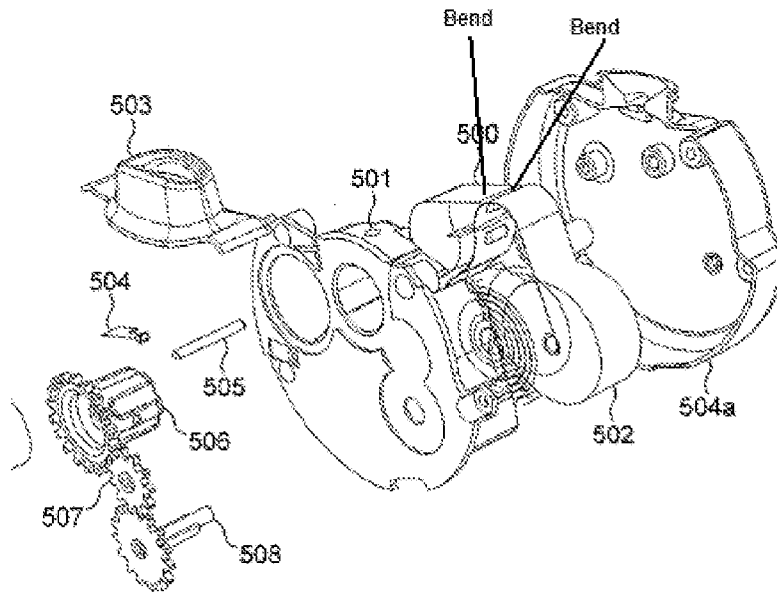


FIG. 9a

Regarding claim 12, Edgerley discloses the conveying mechanism having a drive mechanism (510, 512, 514, 515, 516) to impart drive to the capsule chain in response to the lever arm (518) (see pg. 34, lines 20-30).

Regarding claim 13, Edgerley discloses the drive mechanism having a drive wheel train (foil haul off assembly (506, 507, 512, 514, 515, 516)).

Regarding claim 14-16, Edgerley discloses the conveying mechanism having sprockets (506, 512) rotatably mounted in the housing and engaging the capsule chain (500) for advancement in the track and the drive wheel train having plurality of wheels (514, 507 and wheels on the bottom of index wheel) rotatably mounted in the housing, each wheel coupled co-axially its associated

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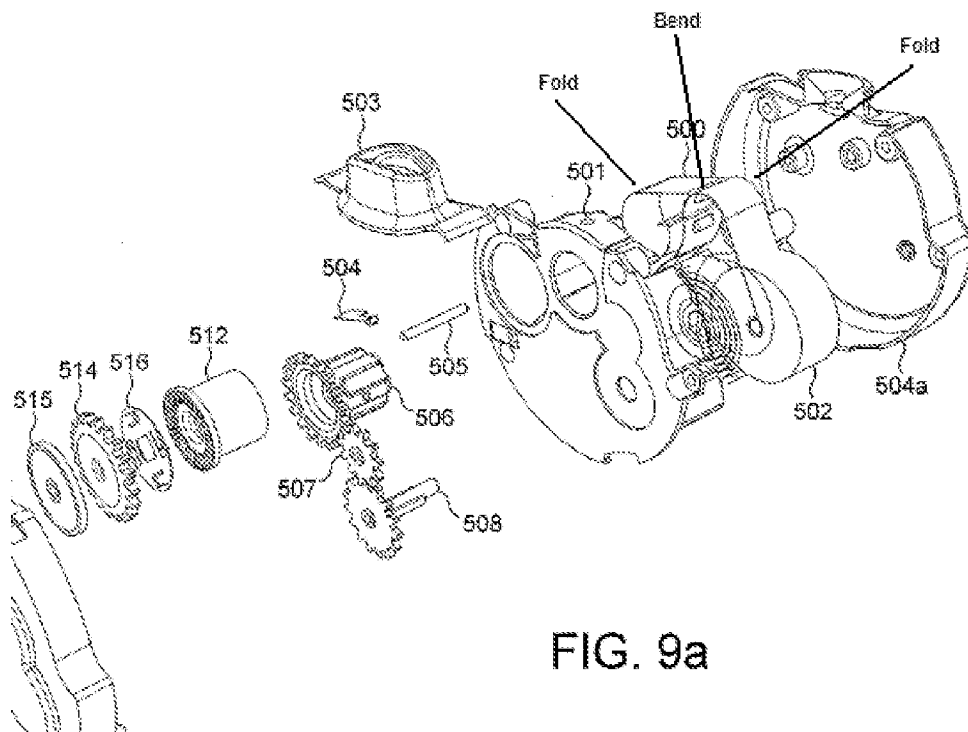
sprocket such that rotation of the wheels causes rotation of the associated sprockets.

Regarding claim 17, Edgerley discloses each sprocket having a spindle (511, 505) mounted on the associated wheels at its axis of rotation.

Regarding claim 18, Edgerley discloses a predetermined wheel (514) of the drive wheel train in engagement with the lever arm (518) which is movable by the user and the movement of the lever arm causes rotation of the predetermined wheel to drive the drive wheel train (see pg. 34, lines 20-30).

Regarding claim 19-20, Edgerley discloses the drive wheel train being spur gears (see figure 9a).

Regarding claims 29-30, as best understood by the examiner, Edgerley discloses the track (500) having a fold section for space-saving configuration, the track having a bend inside of the fold section and a sprocket (506) located at the bend (see figure below).



6. Claims 1, 21-22, 27-28 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Elliott (3870046).

Regarding claim 1, Elliot discloses in figure 6 , a hand-held device having a housing (21), inner area of the housing defining a track, a chain of capsules (34) in the track and a conveying mechanism (24, 26) to convey the chain along the track (see column 3, lines 41-62).

Regarding claims 21-22, Elliot discloses in figure 6, the capsules (34) having elongate, generally cylindrical bodies, arranged upright in the track relative to the mouthpiece in the track in side-by-side relation (see figure 6).

Regarding claim 27-28, Elliot discloses the track/chain (see figure 6) being endless (circular).

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Regarding claim 31-32, Elliot discloses the device used as an inhalation device (see mouthpiece 22).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/595615. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the copending claims and the instant claims are minor and obvious from each other. For example, the instant claim 1 is merely broader than the copending claim 1. Although the copending claim 1 does not include the limitation of housing and conveying mechanism, however it is obvious that a

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hand-held device must include housing and the copending claim 1 recites that capsule are conveyable. It is clear that all of the elements of claim 1 are found in copending claim 1. Similar arguments exist for instant claims 2-32. Hence, the instant claims do not differ from the scope of the copending claims 1-25.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newell et al. (4811731), Haber (4733797), Dumont et al. (6021918) and Wright, JR (3297198) discloses variable hand-held device with capsule dispensing mechanism.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN WON whose telephone number is (571)270-7129. The examiner can normally be reached on Monday thru Friday, 9:00 A.M to 5.00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571)272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN WON/
Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771